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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/714,475	11/17/2003	Soichi Obata	244809USORE	3226
22850 7590 12/05/2007 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER HAMILTON, LALITA M	
			ART UNIT 3691	PAPER NUMBER
			NOTIFICATION DATE 12/05/2007	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/714,475

Applicant(s)

OBATA, SOICHI

Examiner

Lalita M. Hamilton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. <u>11282007</u> |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

On October 10, 2007, the Examiner stated that the preliminary oath/declaration submitted by the Applicant would be sufficient to overcome the final rejection. On October 19, 2007, the Applicant filed a response to the final rejection correcting deficiencies in the oath/declaration to overcome the 35 USC 251 rejection. Shortly thereafter, clarification of the treatment of reissue applications that only add one or more narrower claims was made (see below). In view of the clarification, the final rejection has been withdrawn, and a new non-final rejection is being issued.

35 U.S.C. 251 Rejection

Claims 1-20 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the reissue application is set forth in the discussion below in this Office action.

It is Office policy that the reissue statute does not provide a basis for reissuing a patent when the patentee states (in the oath or declaration) ONLY that certain claims could have been claimed, without indicating that in the absence of these claims, (1) the patent is wholly or partly inoperative (because the patent claims were too narrow to protect the disclosed invention), or (2) that the patent is wholly or partly invalid because one or more patent claims is too broad....It is the Office's position that claims added to a reissue application must correct one or more presently existing errors in the scope (breadth) of coverage provided by the patent claims, or must correct another claim defect that would render the claim(s) inoperative or invalid, unless another reissuable

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error under 35 USC 251 is identified and is being corrected in the reissue application (see MPEP 1402 8th Ed., Rev. 5 for errors correctible by reissue under 35 USC 251)....Although a reissue applicant may regard the absence of certain narrower claims to be "an error", the original patent is simply not wholly or partly inoperative to protect the invention due to the absence of a narrow claim when the invention to which that narrow claim is directed is covered by one or more broader existing patent claims that the reissue applicant does not propose to either narrow or cancel. The original patent is also not wholly or partly invalid by reason of one or more claims being too broad if the reissue applicant does not propose to either narrow such claims by amendment or cancel them. The allegation that the patent is defective for "claiming less than patentee had a right to claim" does not mean there are too few claims, but rather that the patent claims are not broad enough to protect the invention (and the patent is thereby inoperative to protect the disclosed invention). Therefore, where no broadening claims are presented, such an allegation does not correctly set forth a reissuable error under 35 USC 251....All claims pending in a reissue application in which (1) the reissue applicant presents one or more claims that are all narrower than the broadest patent claim(s), and (2) the only error that supports the reissue is that the additional claims "could have been claimed" or that the patentee was claiming "less than" patentee had the right to claim, are to be rejected as failing to state an error under 35 USC 251. The rejection will be maintained unless (1) the reissue application is amended to include a reissue oath/declaration that specifies a different "error" that renders the patent wholly or partly inoperative or invalid in accordance with 35 USC 251, and (2) includes a

corresponding correction of that error. Where the only error that a reissue applicant desires to correct in a reissue application is to be corrected by the presentation of claims that are all narrower than one or more broader patent claims, then (1) the error relied upon by the reissue applicant must be described in the reissue oath/declaration as correcting the error of claim "more than" the patentee had the right to claim, and (2) that the correction of such error include cancellation and/or amendment of one or more patent claims that the patentee regards as being too broad. All claims presented in the reissue application that does not comply with these requirements will be rejected as failing to state an error under 35 USC 251.

Response to Arguments

Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lalita M. Hamilton whose telephone number is (571) 272-6743. The examiner can normally be reached on Tuesday-Thursday (6:30-2:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kalinowski Alexander can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



LALITA M. HAMILTON
PRIMARY EXAMINER